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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/828,417	03/28/1997	HIROFUMI MIRASAKI	P9702-MG	4906
7590 LACKENBACH SIEGEL MARZULLO ARONSON & GREENSPAN ONE CHASE ROAD SCARSDALE, NY 10583			EXAMINER D AGOSTINO, PAUL ANTHONY	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 09/28/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/828,417

Applicant(s)

MIRASAKI ET AL.

Examiner

Paul A. D'Agostino

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/28/1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 02/25/2009. Claims 45-46 and 50 have been amended. Claims 45-52 are now pending in this application.

Response to Amendments

1. This acknowledges Applicant's amendments to remedy the rejections under 35 U.S.C. 112, first paragraph. Thus, the rejection of Claims 45-52 is withdrawn.

Claim Objections

2. Claim 47 is objected to because of the following informalities: The preamble is missing the word "A". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 45-47 and 50 are rejected under 35 U.S.C. 102(b) as anticipated by JP 08-215433 to Toyama Shigeki.

Shigeki discloses a sound {speech} generation device and method for a game machine (Title and "game play-by-play broadcasting equipment which broadcasts expansion of a game play-by-play [0001, 0008]), comprising:

a storage unit ("voice data storage means") for storing a plurality of phrase groups composed of a plurality of phrases ("voice data ... corresponding to two or more expansion patterns is beforehand memorized" [0010]) respectively prepared for corresponding conditions ("predetermined data for play-by-play broadcasting" [0009]);

a phrase selection processing unit ("pattern distinction means" [0009]) for monitoring the progress of a game ("to distinguish the game expansion pattern of a game system" [0009]) and selecting a phrase from a phrase group corresponding to a predetermined condition (predetermined condition is established by "two or more selection mold junction data of different contents of junction [0018, 0020-0021]) when the predetermined condition is satisfied (the phrase processing unit identifies a data from among the selection mold junction data equating to an expansion pattern and "output the read-out command of the voice data corresponding to a game expansion pattern" [0009]. Moreover, the data of an expression is chosen randomly wherein a plurality of expressions "correspond to the same game expression pattern" making the game "rich in change" [0021]);

a sound output unit ("speech synthesis means" [0009]) for converting data of the phrase selected by the phrase selection processing unit to a sound signal and outputting sound according to the sound signal ("to compound a sound signal" [0009] and carry-out the voice output of the play-by-play broadcasting corresponding to game expansion" [0011] which "an announcer actually performs" [0021]);

said plurality of phrase groups have a hierarchical structure (the game executes according to "story voice data" which "constitutes the story corresponding to a game

expansion pattern" [0022] and the game expansion pattern in collaboration with the selection mold junction data determines one of a plurality of phrases to announce. In the event of a collision or sudden event ["accident routine" [0099, 0102], the game expansion pattern in collaboration with the selection mold junction data determines one of a plurality of collision phrases to announce and potentially in an excited tone [0072], assigns a priority for interrupting the present broadcasting [0109]. Thus, a hierarchy is evidenced by a) collision phrases occurring after game start phrases and player introduction phrases (see "An example of a fundamental game expansion pattern starting at [0064]; entry mode [0065]; game start [0066, 0083-0089] as distinguished from "concrete play-by-play broadcasting output" [0090] wherein if there is "spin of other vehicles, and course out, exact priority attachment has been carried out and other descriptions may start in the midst of description. In such a case, it is made to talk in the excitement tone ..." [0099] forming a logical, temporal hierarchy structure; and b) the ability to set priorities and interrupt the broadcast imputes a hierarchy arrangement) and including superior {first} phrase groups (plurality of randomly determined non-collision phrases, for example [0083]) and subordinate {second} phrase groups (plurality of randomly determined collision or "accident" phrases, for example [0099]) groups, each superior phrase group includes including to generate a phrase:

a first command for additionally selecting a phrase from a subordinate phrase (in addition to previous expansion game commands, the play-by-play broadcasting, additional commands are deployed so the phrases are "changed intricately" by substituting the previous phrase with another phrase corresponding to the "game

expansion situation" [0023]. Here, when a second collision occurs a command for an additional collision phrase is selected from the subordinate group. "Therefore, a player ... can know detailed game expansion information" [0023] in "real time" [0012]),

a second command for searching a subordinate phrase group and selecting a phrase from the subordinate phrase group (the invention of Shigeki accommodates multiple players [0015] such that collisions of other players will necessitate additional commands for a corresponding game expression phrase to be determined and announced [0015, 0023]), and

a third command for playing no phrase (the stated purpose of this third command for no phrase is to "prevent words of a running commentary from continuing without any pauses". Shigeki issues commands via the junction electronic speech circuit 50 wherein "an example is constituted including the pattern distinction section 52, the speech synthesis section 54, the voice data storage section 56, and the junction change-over section 70" [0056] wherein pauses necessarily must be inserted into a running commentary, for example, where the "voice of the announcer ... and it is desirable to constitute as voice data which moreover had the same rhythm and intonation as actual play-by-play broadcasting" [0057],

wherein when a phrase selected from a superior phrase includes a first command, the phrase selection processing continues to select an additional phrase from a subordinate phrase group designated by the first command; and when a phrase is selected from the superior phrase includes a second command, the phrase selection processing unit searches for a subordinate phrase group designated by the second

command and selects a phrase from that subordinate phrase group; and wherein when the phrase selected by the phrase selection processing unit includes a third command, the sound output unit does not perform the sound output processing (Shigeki discloses examples of a race and a layered system and method of play-by-play announcing driven by commands issued as specified above to deliver the effect of "contents of the play-by-play broadcasting different each time and play-by-play broadcasting by which weariness does not come for a player" [0062]; see also [0056-0070]; Further, [0105-113] disclose an example of different routines where different play-by-play broadcasting can occur including voice substitution area 800 selectable at random depending on the situation. All of the above is related to a layered structure of having phrase pulled out of storage means randomly. [0080-0088] disclose an example of the embodiment with reference to multiple data storage areas for selection based on an action of the game, which in this case is starting the game. [0090-0096] disclose that different voice data may be inserted at different junctions or points in the game).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 48-49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-215433 to Toyama Shigeki.

Shigeki discloses a system substantially equivalent to Applicant's claimed invention. However, Shigeki is silent on the play-by-play languages being different and the voice being a different gender between the two phrase groups.

To provide various genders of the announcers as is well known in viewing any major sporting event whereby the announcers are varied to meet the viewing needs of

the consuming public and to comply with market forces to maintain viewership and ad revenues would only require routine skill in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the routine skill in the art to vary the play by play announcers and languages into the teachings of Shigeki in order to provide play-by-play broadcasting differed each time, and play-by-play broadcasting by which weariness does not come for a player and a gallery can be performed." [0062].

Response to Arguments

8. Applicant's arguments filed 2/25/2007 have been fully considered but they are not persuasive. Applicant argues (see Applicant's Arguments/Remarks pages 9-12) that Examiner has not provided how Shigeki anticipates or renders obvious the claimed invention with sufficient particularity. Examiner has provided a detailed mapping and understanding of the invention of Shigeki as part of the rejection of the claims. In particular, Examiner points out first, second, and third, commands. Applicant argues that Shigeki discloses play-by-play broadcasting in a fixed pattern such that only a random single phrase according to the progress of the game can be selected and that these phrases must be prepared in advance. Examiner respectfully disagrees with this mental model of Shigeki. Shigeki's play-by-play is responsive to events occurring in the play of the game, for example, for collision and non-collision events ("accident routine") explained in the rejection of the claims. The events occur randomly and as such the

synthesis of phrases for the play-by-play occur in real time in order to respond to a wide variety of game situations. Applicant argues that Shigeki does not disclose a third command. Examiner respectfully disagrees and has provided an example of a third command as part of the rejection of the claims. Thus, the rejection of Claims 45-52 is maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/Paul A. D'Agostino/
Examiner, Art Unit 3714